



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/563,022  | 11/21/2006  | Roland Edelmann             | 283357US0PCT        | 1934             |
| 22850 7590 05/16/2011<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                             |                     |                  |
| EXAMINER<br>TOSCANO, ALICIA   |             |                             |                     |                  |
| ART UNIT<br>1766  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>05/16/2011   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/563,022

**Applicant(s)**

EDELMANN ET AL.

**Examiner**

ALICIA TOSCANO

**Art Unit**

1766

***—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —***

THE REPLY FILED 05 May 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/ALICIA TOSCANO/  
Examiner, Art Unit 1766

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. Applicant argues Mehnert describes a capsule of metal oxide core and a silico-organic shell in a synthetic resin and does not disclose the liquid dispersion of less than 1500 mPas. The Examiner disagrees. At the time of the reaction, the formulation has the claimed ratio. Applicant can show this to not have the viscosity of the instant claims but without such a showing Applicant's arguments are not persuasive. Applicant's end product of the Examples is a reacted oxide/silane composition, evidenced by the release of alcohol therein. This is the same reaction that occurs in Mehnert. At the time of formulation the silane of Mehnert meets the solvent requirements of the instant claims. Applicant's claims are merely drawn to a composition. That the examples of Mehnert require kneading are moot since Mehnert discloses that viscosities of 800-1200 Pas are preferred. The diluents of Mehnert DYNASYLAN VTMO (Column 6 line 60) are added at the time of the reaction (Ex 1). These diluents are added specifically to reduce the viscosity of the formulation. Thusly that Mehnert calls his composition as a paste is not persuasive, since such a paste is disclosed in the Ex to be the ready-to-use lacquer, and since said lacquer is disclosed to preferably have a viscosity of 800-1200. Arguments that Mehnert dilutes his paste with acrylates is misleading, given the disclosure discussed above in Column 6. As such Applicant's arguments are not persuasive and the rejection stands as set forth previously.

Regarding Edelman Applicant argues reaction to form the shell is recognized because alcohol is distilled off. Applicant argues slow addition of oxide particles are disclosed in Edelman. The Examiner disagrees. Applicant's examples imply the same type of reaction since alcohol is distilled off therein and since the same composition requirements are met in both references. Applicant's examples do not add the oxide all at the same time, thusly that Edelman does not add all his particles at one time is found moot. Further, since some reaction occurs at the time of addition in Applicant's examples it is unclear to the Examiner how the silane to oxide ratio is met by the final product therein. Applicant's claims may be more appropriately limited to the end siloxane concentration, however, since the silane of the claims reacts (as evidenced by alcohol removal) it is unclear to the Examiner how one can have the claimed silane to oxide ratio. The Examiner requests evidence to the contrary. As such Applicant's arguments herein are not persuasive and the rejection stands as set forth previously.

Applicant argues Hardman does not suggest the core-shell capsule of Mehnert and the two references thusly are not analogous. Applicant argues Hardman does not make up for the deficiencies of Mehnert. The Examiner disagrees. The same reaction occurring in Hardman (hydrolyzation of silane) is occurring in Mehnert. Mehnert discloses that acids may be used, but does not disclose the concentration thereof. Hardman is used as a teaching of how much acid is known to be used during the hydrolysis of silanes. Hardman is thusly solving the same hydrolysis problem as Mehnert. Mehnert is not deficient in regards to the solvent, as set forth above, as such Applicant's arguments are not found persuasive and the rejection stands as set forth previously.

Applicant argues the non-statutory ODP rejection over Mehnert v. Hardman is improper for the same reasons argued above, the Examiner disagrees for the same reasons set forth above.

Applicant argues the non-statutory ODP rejection over Edelman is not proper for reasons set forth above, the Examiner disagrees for reasons already set forth above.